

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                            |                                          |
|----------------------------|------------------------------------------|
| Applicant                  | Bruce L. Kennedy                         |
| Application No. 10/662,599 | Filing Date: September 15, 2003          |
| Title of Application:      | Video Recording and Image Capture Device |
| Confirmation No. 2356      | Art Unit: 3739                           |
| Examiner                   | Philip R. Smith                          |

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Appeal Brief Under 37 CFR §41.37**

Dear Sir:

A Notice of Appeal from the final rejection of Claims 19-31 and 46-49, all pending claims of U.S. Patent Application No. 10/662,599, having been filed on April 18, 2008, Applicant accordingly files its Appeal Brief in connection with its appeal. A Claims Appendix is submitted herewith, as are Appendices related to evidence previously submitted and decisions related to the case.

**(i) Real Party In Interest**

The real party in interest is Karl Storz Imaging, Inc., of Goleta, CA , USA assignee of the present patent application.

**(ii) Related Appeals and Interferences**

There are no related appeals, interferences or judicial proceedings known to Appellant, the Appellant's legal representative, or Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(iii) Status Of Claims**

Claims 19-31 and 46-49, all pending claims of the present application, stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto in the Claims Appendix.

**(iv) Status Of Amendments**

There are no pending or unentered Amendments. On August 1, 2006, Appellant filed a Response to the Office Action dated July 7, 2006. Appellant made amendments to the claims in the Response to the Office Action dated July 7, 2006, which were acknowledged, entered and addressed in the Office Action dated August 17, 2006 to which Appellant file a Notice of Appeal and an Appeal Brief. In response, the Examiner withdrew his previous rejections and issued another Office Action dated July 25, 2007. On October 24, 2007, Appellant filed a Response to the July 25, 2007 Office Action. Appellant

added a new claim 49, which was acknowledged and entered in an Office Action dated January 24, 2008 from which Appellant now appeals.

#### **(v) Summary Of Claimed Subject Matter**

Claim 19 the sole independent claim pending in the case.

##### Independent Claim 19

Claim 19 is directed toward medical video instrument having touch screen control. (Par. 2, 18, 24, 45, 52-54, FIGS. 2, 4, 5a-5c, 14a-14b & 15.) Claim 19 further includes a touch screen for entering control commands to control the medical video instrument. (Par. 24, 36-38, 47, 52-59, 71-72, 78, FIGS. 2, 4, 5a-5c, 14a-14b & 15), where the medical video instrument is inserted into a body cavity and generates an image stream representative of the body cavity and displayed on the touch screen. (Par. 13, 40-44, 50, 73-74, 85 & FIG. 1.) Claim 19 still further includes a processor for receiving the control commands and for generating control signals to operate the medical video instrument. (Par. 24, 45, 47, 88-91 & FIG. 4.) Claim 19 also includes a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing. (Par. 24, 55, FIGS. 5a-5c & 15.)

#### **(vi) Grounds Of Rejection To Be Reviewed On Appeal**

(1) Claims 19-31 and 46-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0076410 ("Beutter") in view of U.S. Patent No. 6,411,851 ("Winkler").

(2) Claim 48 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter in view of Winkler and further in view of U.S. Published Patent Application No. 2003/0060678 (“Watai”).

(3) Claims 19 and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter in view of U.S. Published Patent Application No. 2002/0149706 (“Rosen”).

## **(vii) Argument**

### Prior Art Rejections

The Examiner has submitted that “it would have been obvious . . . that the “operating room control center 42” having a “touch screen” disclosed by Beutter take the particular form disclosed in Winkler. A skilled artisan would be motivated to do so in order to minimize space requirements when the control center is not in use, and to reduce potential damage to the touch screen.” (Official Action 1/24/08, p. 3)

Initially, Appellant notes that Beutter discloses a device that is provided in an operating room environment (e.g. system utilizes an “operating room control center”) (Beutter, Par. 30), whereas Winkler “relates to portable computer equipment for use with implantable medical devices (IMDs).” (Col. 1, Ins. 7-8) Accordingly, the motivations given (e.g. “minimize space requirements . . . and reduce potential damage”) while applicable for the portable device taught in Beutter, simply don’t apply to the operating room system taught in Beutter. For example, the rough handling a portable device may be subjected to when transported from one location to another is not an issue for an operating room system that is non-portable but is provided to be permanently maintained in an operating room. Likewise, the space constraints and difficulty in handling multiple

pieces of equipment to be carried from location to location is simply not an issue for a static operating room system that once installed, is not thereafter moved.

Obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). In this case, the Examiner has simply stated that the benefits listed for a portable device would per se be obvious to use in connection with a non-portable system used in an operating room environment. Appellant disagrees as this is not taught in Beutter, and further submits that such a modification would eliminate other beneficial functionality for the system taught in Beutter. For example, Beutter teaches that the camera control unit 34 (CCU) is separate from both the operating room control center 42 (ORCC) and the monitor 36. (See, Figure 1; Pars. 26-30) To modify Beutter to position the monitor in a flip-up case containing the CCU 34 would limit the ability of the physician to position the monitor, for example, in a convenient location over the patient during a procedure for optimum viewing by the physician.

The presently claimed invention is intended for use in an operating room environment, for example, the specification teaches use of a “network” and “interfacing with the Karl Storz®, Inc. Storz Communication Bus (SCB).” (Pars. 49) The “bus” that the device is capable of being coupled with is described as a “vertically stacked IDE bus 116.” (Pars. 48, 70; “the bus being vertically stacked and connected to the main board”, Abstract). The medical video instrument as described herein, is a device that may be vertically stacked in a rack. (Par. 11) For example, claim 21 recites that “said housing and said touch screen include stackable mating plug portions.” This configuration, however, is not portable, but would be a device that is mounted into a rack with other devices. Appellant further respectfully submits that modification of Beutter according to Winkler would not result in a device that was functional. For example, when the instrument is rack-mounted, there is no ability to tilt the device upward as taught in Winkler because there is equipment mounted above (and below) the device in a rack mounted

arrangement. Rather, in a rack mounted system including “stackable mating plug portions” as per claim 21, the screen would need to extend from the device as illustrated in Figures 5a-5c.

For example, with regard to claim 49, neither Beutter nor Winkler teach or disclose that “when said touch screen is in the first position, said touch screen is positioned within an interior cavity of said housing and when said touch screen is moved to the second position, the touch screen positioned at least partially outside of said cavity.” Rather, Winkler is limited to disclosing that the touch screen folds downward and lies flat along the outer surface of the housing. There is no interior cavity of said housing within which the touch screen is positioned. In fact, Winkler teaches away from this limitation stating that “[d]isplay unit 206 is disposed on the upper surface of housing 202.” However, it should be noted that positioning the touch screen within the housing allows the system to be mounted within a rack system as is taught in the originally filed written specification. (Par. 54) Modification of Beutter in view of Winkler would still not arrive at claim 49 and would not result in a device that would be usable in a rack mounted arrangement.

Appellant further respectfully submits that in the rack mounted system configuration, the device and the touch screen is unpluggable from the housing as per claim 20 and illustrated in Figure 14a. Neither Beutter nor Winkler teach or disclose this limitation nor has the Examiner provided any motivation as to why it would be obvious to further modify the prior art to provide such a configuration as none of the references are provided for a rack mounted arrangement.

It is the Examiner's burden to establish *prima facie* obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co.*

*v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, the Examiner has not identified all the elements of claim 20-21 or 49, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

Appellant still further submits that claim 22 further recites “said touch screen can be used by a plurality of medical instruments.” The Examiner has stated that “the touch screen disclosed by Beutter in view of Winkler can inherently be used by a plurality of medical instruments” but provides no evidence to support this statement. (Official Action 1/24/08, p. 3) Appellant respectfully submits that it is incumbent upon the Examiner to establish the factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). While the Examiner has not specifically stated that Official Notice is taken with regard to the limitation of claim 22, it appears the Examiner is alluding to this as there is no teaching in either reference nor has the Examiner cited to any location in the prior art to support this conclusion.

With respect to the appropriateness of taking Official Notice in general, the MPEP and case law make crystal clear that the situations when taking Official Notice is appropriate are extremely limited. More specifically, MPEP 2144.03, in part, states the following:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are

not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

The MPEP and case law also make clear the fact that if Applicant challenges a factual assertion as not properly officially noticed, the Examiner must support the finding with adequate evidence. In this regard, MPEP 2144.03, in part, states:



If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

In the present case the Examiner has simply stated that that "the touch screen disclosed by Beutter in view of Winkler can inherently be used by a plurality of medical instruments." (Official Action 1/24/08, p. 3; *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.") Accordingly, the rejection of claim 22 is also improper.

**Conclusion**

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of claims 19-31 and 46-49 is patentable over the cited prior art. As such, Applicant respectfully requests that the rejections of each of claims 19-31 and 46-49 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of claims 19-31 and 46-49.

Respectfully submitted,

May 13, 2008

/Wesley W. Whitmyer, Jr./  
Wesley W. Whitmyer, Jr., Registration No. 33,558  
Steven B. Simonis, Registration No. 54,449  
Attorneys for Applicant  
ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619  
203 324-6155

**Claims Appendix  
to Appeal Brief Under 37 CFR §41.37  
Serial No. 10/662,599**

1. (withdrawn) A device for medical video recording comprising:  
an endoscope;  
a digital media; and  
an imager in communication with said endoscope, said imager converting energy received from said endoscope to signals that are contemporaneously stored onto said digital media.
2. (withdrawn) The device of claim 1 further comprising an encoder in communication with said imager, said encoder compressing said signals.
3. (withdrawn) The device of claim 1 wherein said media is an optical disc.
4. (withdrawn) The device of claim 3 wherein said media is a digital versatile disk.
5. (withdrawn) The device of claim 4 wherein said stored signals are stored as VOB files.
6. (withdrawn) The device of claim 2 wherein said encoder is an MPEG encoder.
7. (withdrawn) The device of claim 1 wherein said imager is a solid state device.
8. (withdrawn) The device of claim 1 wherein said imager includes a still frame grabber.

9. (withdrawn) The device of claim 8 wherein said imager stores still frames on said media.
10. (withdrawn) The device of claim 1 further including a touch screen for entering control commands for said imager and said endoscope and said touchscreen is responsive to a touch by a user.
11. (withdrawn) The device of claim 10 further including a housing, said housing enclosing said imager.
12. (withdrawn) The device of claim 11 wherein said touch screen is at least partially retractable within a footprint of said housing.
13. (withdrawn) The device of claim 11 wherein the touch screen is slidable at least partially out of a footprint of said housing.
14. (withdrawn) The device of claim 11 wherein the touch screen is deflectable relative to said housing.
15. (withdrawn) The device of claim 11 wherein the touch screen is pivotable relative to said housing.
16. (withdrawn) The device of claim 10 wherein said touch screen displays said signal.
17. (withdrawn) The device of claim 1 wherein said signal is electromagnetic energy.
18. (withdrawn) The device of claim 1 wherein said signal is direct current energy.

19. (previously presented) A medical video instrument having touch screen control comprising:

a touch screen for entering control commands to control said medical video instrument;

said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen;

a processor for receiving said control commands and for generating control signals to operate said medical video instrument; and

a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing.

20. (original) The medical instrument of claim 19 in which said touch screen is unpluggable from said housing.

21. (original) The medical instrument of claim 19 in which said housing and said touch screen include stackable mating plug portions.

22. (original) The medical instrument of claim 20 in which said touch screen can be used by a plurality of medical instruments.

23. (original) The medical instrument of claim 19 in which said touch screen is deflectable about an axis of said housing.

24. (original) The medical instrument of claim 23 in which said touch screen is easier to deflect in one direction than in the other direction.

25. (original) The medical instrument of claim 23 in which said touch screen is more difficult to deflect in the opening direction than in the closing direction to permit said touch screen to be tapped without unintentionally deflecting said touch screen.
26. (original) The medical instrument of claim 19 in which said touch screen presents a keyboard to a user.
27. (original) The medical instrument of claim 19 further comprising a sensor in communication with said processor, said sensor receiving control signals to operate said medical instrument.
28. (original) The medical instrument of claim 19 further comprising a speech recognition module executing on said processor, said speech recognition module receiving voice signals that control said medical instrument.
29. (original) The medical instrument of claim 19 further comprising a expert system executing on said processor, said expert system generating control signals to operate said medical instrument.
30. (original) The medical instrument of claim 19 in which said touch screen slides out of said housing.
31. (original) The medical instrument of claim 19 in which said touch screen slides out of said housing and is deflectable.
32. (withdrawn) A video recording and image capture device for recording data comprising:  
a main board;  
a first and second bus in communication with said main board;

an interface operable to receive a signal and forward the signal to said first bus;  
an imager in communication with said main board, said imager recording said signal while contemporaneously writing said signal, said imager operably connected to said second bus; and

a touch screen connected to said second bus and responsive to a touch by a user, said touch screen for entering control commands for said interface.

33. (withdrawn) The device of claim 32 wherein said interface is operable to receive and process said signal into an MPEG stream, said interface connected on said first bus to the main board.

34. (withdrawn) The device of claim 32 and 33 wherein said imager records and writes said files as an MPEG stream.

35. (withdrawn) The device of claim 32 further comprising a database module executing on said main board, said database module structuring storage of said files.

36. (withdrawn) The device of claim 32 further comprising a sensor in communication with said main board, said sensor generating control signals to operate said device.

37. (withdrawn) The device of claim 32 further comprising a speech recognition module executing on said main board, said speech recognition module generating control signals to operate the device.

38. (withdrawn) The device of claim 32 further comprising an expert system executing on said main board, said expert system generating control signals to operate said device.

39. (withdrawn) The device of claim 32 further comprising a stereoscopic module executing on said main board, said stereoscopic module associating a plurality of files to provide stereoscopic images on said interface.

40. (withdrawn) The device of claim 32 wherein said interface comprises at least one relay to route an input signal to a corresponding output connector for providing an output signal regardless of the operation status of said device.

41. (withdrawn) An interface for processing a signal for recording video into a multiple frame layer comprising:

- a controller for an inter-ic bus for providing a multiple master digital connection;
- an analog to digital converter for converting a video signal to a first digital stream, said converter operably connected to said inter-ic bus;

- a video compression and decompression integrated circuit for encoding said first digital stream into a second digital stream having frames, and decoding said second digital stream, said video compression and decompression integrated circuit operably connected to said inter-ic bus; and

- a programmable buffer for selectively saving frames handled by said controller, said buffer operably connected to said controller and said video compression and decompression integrated circuit, and said buffer inserting said frames into said second digital stream for decoding.

42. (withdrawn) A method for recording an MPEG file for documenting surgical procedures while displaying an MPEG stream and a plurality of selected still image files corresponding to the MPEG stream, comprising the steps of:

- providing a first digital data stream comprising a video signal,
- providing a second digital data stream comprising an audio signal,
- multiplexing an MPEG data stream from said first and second digital data stream,
- streaming said MPEG data stream to an imager operably connected on a bus;



writing said MPEG stream to said imager;  
displaying said MPEG stream on a display unit;  
selecting a number of frames from said MPEG stream;  
converting the frames to still image files; and  
multiplexing a signal to said display unit by adding the still image files.

43. (withdrawn) The method of claim 42 in which said still image files are in JPEG format.

44. (withdrawn) The method of claim 42 in which said still image files are in BMP format.

45. (withdrawn) The method of claim 4 in which the still image files are in TIFF format.

46. (previously presented) The medical video instrument according to Claim 19 wherein said medical video instrument generates video data that is displayed on said touch screen.

47. (previously presented) The medical video instrument according to Claim 19 further comprising a video screen coupled to said processor, and wherein said medical video instrument generates video data that is displayed on said video screen.

48. (previously presented) The medical video instrument according to Claim 19 wherein said medical video instrument further comprises a storage for storing the image stream.

49. (previously presented) The medical video instrument according to Claim 19 wherein when said touch screen is in the first position, said touch screen is positioned

within an interior cavity of said housing and when said touch screen is moved to the second position, the touch screen positioned at least partially outside of said cavity.

**Related Proceedings Appendix  
to Appeal Brief Under 37 CFR §41.37  
Serial No. 10/662,599**

There are no related appeals, interferences or judicial proceedings known to Appellant, the Appellant's legal representative, or Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.